

REMARKS

The preceding amendments and following remarks are filed in response to the Official Action of the Examiner mailed August 30, 2002, setting a three-month shortened statutory period for reply. Claims 57 and 60 have been cancelled, and claims 1-15, 17-22, 24-42, 44-48, 50-56, and 58-59 remain pending. Claims 1, 10 and 31 have been amended. Reconsideration, examination, and allowance of all pending claims is respectfully requested.

In paragraph 1 of the Office Action, the Examiner objected to claim 10 for including an informality. With the above amendment, the misspelled word "kit" has been replaced with the correct term, "knit". The objection is believed overcome.

In paragraph 3 of the Office Action, the Examiner rejected claims 1, 8, 9, 31, 36, 37 and 56 under 35 U.S.C. §102(b) as being anticipated by Cook, U.S. Patent No. 4,637,396.

Applicants respectfully traverse the rejection, at least in part because Cook appears to merely suggest a braided section for preventing over-expansion of an inflatable balloon. However, in the interest of moving the application to issue, Applicants have amended independent claims 1 and 31 to include limitations recited in now cancelled dependent claims 57 and 60, respectively. The new recitation states "wherein the knit tubular member is generally not radially expandable." This recitation is clearly inconsistent with the balloon catheter portion suggested by Cook, which must be radially expandable. The amendment is also based upon incorporation of claims which the Examiner did not reject under 35 U.S.C. §102(b) as being anticipated by Cook.

In light of the above amendments and remarks, independent claims 1 and 31, and dependent claims 8, 9 and 56 (which depend from claim 1) and 36-37 (which depend from claim 31) are believed to be clearly patentable over Cook.

In paragraph 6 of the Office Action, the Examiner rejected claims 1-9, 13-15, 17-22, 24-27, 31-37, 40-43, 44-48, 50-56, 58 and 59 under 35 U.S.C. §103(a) as being unpatentable over Samson, U.S. Patent No. 5,702,373, in view of Cook. After carefully reviewing the cited references, Applicants traverse the rejections and assert that there would be no motivation to combine these references.

Applicants note that “if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); MPEP §2143.01. As applied to the present application, the law requires a finding that the elements extracted from Cook into Samson by the Examiner would no longer perform their intended purpose as modified.

Cook suggests a knitted layer for use in an inflatable balloon:

... The balloon includes an impervious elastic wall for retaining pressure therein, the balloon being reinforced by a knitted fabric layer to limit the maximum expanded diameter of the balloon.

Cook at column 1 lines 48-52.

Samson suggests a composite super-elastic alloy braid reinforced catheter. The Examiner states on page 3 of the Office Action, in paragraph 6, that “Samson further discloses ... a braided tubular member that is generally not radially expandable.” However, the balloon suggested by Cook must be radially expandable to perform its intended function. Samson appears to suggest the opposite, where the braided tubular member is not radially expandable. If the knitted fabric tubular member of Cook were given the characteristics called for by Samson, the balloon would not be capable of expanding and would be unsatisfactory for its intended purpose. Hence there would be no motivation for the combination of these references.

The Examiner also states that it would be obvious:

... to simply modify the braided reinforcement layer of Samson with the knitted reinforcement member taught by Cook for the well known purpose of reinforcement of a device for the well known purpose of adding rigidity along certain portions of a catheter body and/or to help prevent undesirable characteristics during usage such as kinking of the catheter tube.

Office Action at paragraph 6 of page 4.

However, the knitted reinforcement member in Cook is used not to prevent kinking or to add rigidity, but instead to prevent overinflation of the balloon. There would be no motivation to incorporate a device adapted to prevent balloon overinflation, as shown by Cook, for a completely different use (reinforcement to prevent kinking and add rigidity). Likewise, there appears to be no suggestion in either reference for such a combination.

Finally, as noted in the previous paragraph, the knitted reinforcing member suggested by Cook has a different purpose than the braided reinforcement member suggested by Samson. In light thereof, Applicants respectfully disagree with the Examiner's contention that a knitted reinforcing member was known to be "equivalent" to a braided reinforcing member.

Applicants believe that the recitations of independent claims 1, 24 and 31 are clearly patentable over the impermissible combination, noting, for example, the recitation in each claim of a knit tubular member which is either not radially expandable (claims 1 and 31) or formed of metallic elements (claim 24). In light of the above remarks, Applicants believe that claims 1-9, 13-15, 17-22, 24-27, 31-37, 40-43, 44-48, 50-56, 58 and 59 are all clearly patentable over Samson in view of Cook.

In paragraph 7 of the Office Action, the Examiner rejected claims 10-12, 28-30, and 38-39 as being unpatentable over Samson in view of Cook and further in view of Samson et al., U.S. Patent No. 5,549,109. As noted above, there is no motivation or suggestion to combine Samson

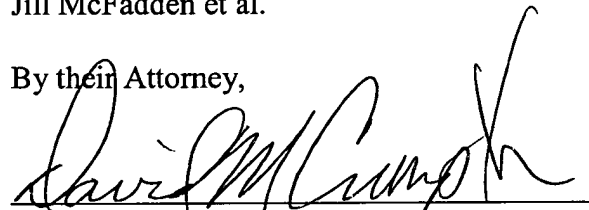
with Cook. Samson et al. appear to provide no additional incentive for such a combination, being instead drawn to a sheathed multipolar catheter and multipolar guidewire, and apparently being relied upon by the Examiner to illustrate multifilament tubes. Therefore, Applicants believe that independent claims 1, 24 and 31, along with dependent claims 10-12, 28-30, and 38-39, respectively, are all patentable over Samson in view of Cook and further in view of Samson et al.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims, namely claims 1-15, 17-22, 24-42, 44-48, 50-56 and 58-59, are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,



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Version with Markings to Show Changes Made

In the Claims:

Claims 57 and 60 have been cancelled.

Claims 1, 10 and 31 have been amended as follows:

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1. (Five Times Amended) A catheter section comprising an elongate tubular member having a proximal end, a distal end, and a passageway defining a lumen extending between the proximal and distal ends, said elongate tubular member comprising a knit tubular member and an inner tubular liner in coaxial relationship with the knit tubular member, wherein the knit tubular member is generally not radially expandable.

10. (Once Amended) The catheter section of claim 1 wherein the knit [kit] tubular member comprises a multifilament wire.

31. (Five Times Amended) A catheter comprising an elongate tubular member having a proximal end, a distal end, and a passageway defining a lumen extending between those ends, said elongate tubular member comprising:

a relatively stiff proximal segment; and

a relatively flexible distal segment comprising a knit tubular member and an inner tubular liner in coaxial relationship with the knit tubular member, wherein the knit tubular member is generally not radially expandable.